

REMARKS

The examiner has rejected claims 5-7, 9-12, and 14-19 for the reasons stated below. Each ground for claim rejection is addressed separately below.

A. 35 U.S.C. § 102(b)

The examiner has rejected claims 5-7, 9-12, and 14-19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,457,898 to Fortin *et al.* (“Fortin *et al.*”). Applicant traverses the rejections of these claims for the reasons stated below.

The examiner has stated that Fortin *et al.* discloses a shoe comprising a sole 12, a toe cap 15, an upper 14, and a metatarsal guard 11 with a convex arch portion, a single right and complementary left leg in contact with the sole, a lip 16 overlapping the toe cap, and a section immediately rearward of the support legs that does not bear against the sole. For the purpose of this claim rejection, the examiner has construed the rearward portion of each leg to be a single leg, with the portion forward of flexibility element 19 comprising a brace or support.

A proper claim rejection under 35 U.S.C. §102(b) requires that each and every element of the claimed invention be shown or taught in the cited reference. It does not appear that this requirement has been met with respect to claims 5-7, 9-12, and 14-16.

Even if the examiner’s were correct in construing Fortin *et al.* to have single left and right legs, Fortin does not show or teach all of the element of independent claim 14. The portion of the Fortin metatarsal guard over a wearer’s instep comprises a lower layer comprising a plurality of longitudinal slits 20 that define a plurality of tongues 21. The central tongue 21’ comprises an extension that forms flap 22, which is folded at its distal end to form a second layer covering the tongues 21. [Col. 3, lines 29-36; Fig. 1.] Nothing in Fortin shows or teaches a convex arch

portion comprising a single layer over a wearer's instep. To the contrary, Fortin *et al.* teaches that flap 22 is required to distribute the load on tongues 21 upon impact by a falling object; it compensates for the weakness of the tongues 21 while allowing movement of the tongues 21 in response to movement of a wearer's foot. [Col. 3, lines 29-30 and 39-41.]

Claims 5-7, 9-12, 15, and 16 each is dependent on independent claim 14. Applicant respectfully submits that these claims are allowable at least for the reasons stated with respect to claim 14.

Fortin *et al.* does not show or teach each and every limitation of claims 5-7 and 9-12, and 14-16 at least for the reasons stated above. Because Fortin *et al.* does not anticipate these claims, applicant requests that this ground for claim rejection be withdrawn.

It also does not appear that the requirement that each and every element of the claimed invention be shown or taught in the cited reference has been met with respect to claim 17. Even if the examiner's were correct in construing Fortin *et al.* to have single left and right legs, Fortin does not show or teach all of the element of claim 17.

Fortin teaches legs with upper ends that flare outwardly as they meet the convex arch portion. These wide legs add weight to the metatarsal guard and increase materials costs. The claimed invention requires a single narrow leg on each side each having a width less than the width of the convex arch portion between the right and left support legs. The narrow leg of the present invention provides footwear having a lighter weight metatarsal guard that Fortin *et al.* while maintaining protection and flexibility. As stated below, the examiner has concluded that claim 18, which requires single left and right legs each having a width less than the width of the

lip, defines allowable subject matter. Applicant respectfully submits that claim 17 is allowable for the same reason applicable to claim 18.

Fortin *et al.* does not show or teach each and every limitation of claim 17 at least for the reason stated above. Because Fortin *et al.* does not anticipate this claim, applicant requests that this ground for claim rejection be withdrawn.

B. 35 U.S.C. § 112, second paragraph

Claims 18 and 19 are rejected under as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. The examiner has stated that lines 9-10 of claim 18 appear to duplicate elements claimed in lines 6-8, rendering the claim vague and confusing. Applicant has amended claim 18 to eliminate any duplication of claim elements. Applicants respectfully requests that this ground of claim rejection be withdrawn.

C. Allowable Subject Matter

The examiner has stated that claims 18 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 18 to overcome this ground of rejection. Applicant respectfully submits that claims 18 (as amended) and claim 19 are allowable.

D. New Claim

Applicant has added new claim 20, which is dependent on claim 17. Applicant respectfully submits that claim 20 is patentable over the cited reference at least for the reasons stated above with respect to claim 17.

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CONCLUSION

Applicant respectfully submits that all of the claims presented satisfy the statutory requirements for patentability and are patentable over the cited reference. Accordingly, applicant submits that the claims are in condition for allowance and requests that a Notice of Allowance be issued.

Respectfully submitted,

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